

## Remarks

### Preliminary Comments

Applicant submitted with his response of December 27, 2005 additional drawings and requested entry of these drawings. Applicant respectfully requests, if appropriate, confirmation of the entry of these drawings.

### Claim rejections – 35 C.F.R. §112

In paragraph 1 on page 2, the Office rejected claims 32 and 35 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. In particular, the Office alleged that the newly recited “guide” and “computer” are new matter.

As briefly discussed with the Examiner via phone, applicant would like to direct the Office to the following disclosure (see response of September 18, 2006):

With regard to the recitation of the “guide” in claim 35, applicant would like to direct the Office’s attention to original claim 12, which specifically refers to guide (1) as well as numeral (1) in Figure 2. The embodiment shown in Figure 2 will allow attachment of a device to hold a playing aid such as a the ones described on page 4, lines 24 to 34 of the disclosure.

With regard to the recitation of a “computer” in claim 32, applicant would like to direct the Office’s attention to the disclosure on page 3, first three lines, but in particular to page 5, lines 4 to 28, of the English specification.

Accordingly, applicant submits that the original application provides “adequate support” for the claims and describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention (See, e.g., MPEP § 2163 citing Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319 (Fed. Cir. 2003)). Applicant notes that it is well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification (MPEP § 2163).

### **Memorandum of Interview**

Applicants representative briefly called Examiner Lockett on March 22, 2007 and left a message to point the Office to the discussion of the 35 USC §112, first paragraph rejection of claims 32 and 35 in applicants' response of September 18, 2007 (see above). The Examiner acknowledged this discussion in a message for the undersigned and requested that applicant's representative explain the guide in claim 35. The undersigned did this in form of a telephone message she left for Examiner Lockett. The undersigned explained that, e.g., as shown in Figure 2 the guide will allow attachment of a device to hold a playing aid such as the ones described on page 4, lines 24 to 34.

For the reasons given above, applicant submits that a written description for claims 32 and 35 is provided. These claims, which are not otherwise rejected, should thus be in condition for allowance.

### **Obviousness**

In paragraph 3, the Office rejected claims 15 to 22, 24 to 26, 28 to 31, 33, and 36 under 35 U.S.C. §103(a) as being obvious over United States Patent 6,512,169 to Santini (hereinafter "Santini") in view of "Making simple musical instruments," 1995 (hereinafter "Hopkin"), in view of (1) the previously discussed disclosure of Hopkin of a guiro on pages 42 to 43 (Scrapers #1: "Guiro") as well as in view of (2) the newly cited disclosure of a xylophones on page 16 of Hopkin. In the context of a xylophone, Hopkin is said to disclose the use of individual modules or sections to provide for the built-up of sequences of notes.

The Supreme court, in its recent decision of *KSR v. Teleflex, 04-1350* (U.S. Supreme Court, April 30, 2007) advocated against an inflexible application of the "teaching, suggestion, motivation" (TSM) test. The Supreme court was in particular concerned with the fact that the rigid application of this test would lead to a finding of non-obviousness for combinations that constituted extensions of previously existing designs that were doomed to be developed in view of market pressures and technical

advances in the art. The present invention does not fall into the category of innovations resulting from market pressures or technical advances. In fact, xylophones in general, but also as disclosed on page 16 of Hopkin, and guiros in general, but also as disclosed in pages 42 to 43 to Hopkin, have existed next to each other for quite some time (1995).

In view of the fact that the TSM test remains a useful tool in determining obviousness, applicant notes that there is neither teaching, suggestion or motivation in Santini or either of the cited sections of Hopkin's to arrive at the claimed invention. Also, the cited prior art cannot be readily updated to arrive at the present invention (*KSR v. Teleflex*, 04-1350 (U.S. Supreme Court, April 30, 2007, page 22, paragraph 2). In fact, arriving at the invention would, among others, appears to require dissecting guiros and putting them together to allow for a built-up of relative sounds. However, to further highlight the differences between the rejected claims and the prior art, applicant has amended claim 15 further to emphasize the modularity of the invention:

"individual modules or sections of said surface provide for the built-up of relative sounds,  
wherein said individual modules *are combinable* to a combination of modules and for a player to change the combination of modules. (*emphasis added*)

Claims 25 and 33 have been amended accordingly.

This amendment is supported, among others, in original claim 24 (*italized wording* stems from claim 24 (now canceled)), on page 2, lines 29 to 31 and also on page 3, lines 22 to 24 of the disclosure.

The underlined language emphasizes the user implemented variability of the instrument due to its modularity. This modularity allows the player to assemble the modules as he/she wishes allowing for the design of an individualized instrument.

Nothing in Santini's maraca-guiro or one of the excerpts of Hopkin (guiro, xylophone) suggests to the person skilled in the art, employing his/her skill and common sense, a combination of all of the elements of claim 15 as amended. In fact, as discussed above, the cited prior art cannot be readily upgraded to the invention as presently claimed. (*KSR v. Teleflex*, 04-1350 (U.S. Supreme Court, April 30, 2007, page 22, paragraph 2).

Applicants would also like to direct the Office's attention to new claim 37. This claim is supported, e.g., by Figure 3, on page 2, line 37 to page 3, line 1 and page 3, lines 11 to line 20.

In paragraph 3, the Office rejected claim 23 under 35 U.S.C. §103(a) as being obvious over Santini in view of Hopkin and U.S. Patent 4,480,521 to Schmoyer.

Santini and Hopkin have been discussed above. Applicant submits that Schmoyer does not cure the deficiencies of Santini and Hopkin.

Applicant would like to thank the Office for acknowledging the novelty and non-obviousness of the subject matter of claims 27 and 34.

Applicant has shown above that independent claim 15, 25, 33 and 37 are nonobvious over the art presented. These claims should therefore in condition for allowances. Claims 16, 18 to 24, 26, 28 to 31 and 36 which are directly or indirectly dependent on these claims should also be allowable.

Accordingly, allowance of this application is earnestly requested.

The Commissioner is authorized to charge any fee deficiencies or overpayments to undersigns deposit account no. 50-3135.

Respectfully submitted,

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